



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/988,982

11/19/2001

Jennifer L. Hillman

PF-0269-3 DIV

9688

27904

7590

01/24/2003

INCYTE GENOMICS, INC.  
3160 PORTER DRIVE  
PALO ALTO, CA 94304

EXAMINER

RILEY, JEZIA

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 01/24/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/988,982

Applicant(s)

HILLMAN ET AL.

Examiner

Jezia Riley

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,8-11,14-18,28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 3-7 is/are objected to.
- 8) ☒ Claim(s) 1-18 28 and 29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's election with traverse of group II in Paper No. 5, filed on 6/24/02, is acknowledged. The traversal is on the ground(s) that because the Groups II, III, V, IX and X were examined in a parent application then they should be examined in this application. This is not found persuasive for the reasons mentioned in the previous action and because group I can be used in materially different processes and be made by a different process. Further the groups represent separate invention, as shown by the USPTO classification system, as being in different classes and/or subclasses. Therefore if all the groups were searched together it will impose a serious burden on the examiner. Group II and III have been rejoined only. The requirement is still deemed proper and is therefore made FINAL. Therefore Claims 3-7, 12 and 13 are being examined and claims 1, 2, 8-11, 14-18, 28 and 29 are being withdrawn from further consideration.

### ***Claim Objections***

2. Claims 3-6 are objected to because of the following informalities: Claims 3-6 depend from non-elected claims. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12-13 are vague and indefinite because the word "complementary" can mean 5%, 50%, or 90% complementary to the oligonucleotide of a) or b). Does it mean the length of the complement is of the same size of SEQ nucleic acid molecule of a) or

Art Unit: 1637

b), or longer, or smaller. Without some kind of specificity, which one is useable is vague and indefinite. If the applicant mean 100% complement to the nucleic acid molecule of a) or b), the phrase "fully complementary and of the same length" should be included. Further it is unclear of what is meant by a RNA equivalent.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Product Number 1028 of Biolabs Catalog (1986) disclosed on page 61.

The linker of Product Number 1028 comprises a nucleotide sequence that is complementary with a polynucleotide sequence of a) or b) present as follows:

3'-CCGGCCGG-5' Product number 1028  
30-GGCCGGCG-23 Seq ID No: 2

There is a lack of any limitation as to how the claimed polynucleotide is not complementary with a polynucleotide of a) or b). Therefore the product Number 1028 of Biolabs Catalogs have a sequence complementary with a polynucleotide a) or b).


Art Unit: 1637

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is 703-305-6855. The examiner can normally be reached on 9:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

January 22, 2003

  
JEZIA RILEY  
PRIMARY EXAMINER